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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,304	08/29/2001	Albert S. Deutsch	PISCES 00.01 DIV	8148

7590 05/22/2002

Norman P. Soloway  
Hayes, Soloway, Hennessey,  
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Tucson, AZ 85701

EXAMINER
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FUNK, STEPHEN R

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 05/22/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/941,304

Applicant(s)  
Deutsch et al.

Examiner  
Stephen Funk

Art Unit  
2854



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above, claim(s) 12-14, 17, and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other: \_\_\_\_\_

Art Unit: 2854

This application contains claims directed to the following patentably distinct species of the claimed invention:

- a) coating with an effective pH;
- b) coating with an effective water concentration;
- c) coating imparted with insolubility by hydroxyl ions.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Norman Soloway on May 2, 2002 a provisional election was made with traverse to prosecute the invention of Group c), claims 15 and 16.

Affirmation of this election must be made by applicant in replying to this Office action.

Art Unit: 2854

Claims 12 - 14, 17, and 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

The use of numerous trademarks have been noted in this application on at least pages 10, 11 and 13. Each letter of each trademark should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no disclosure of imparting insolubility to the coating with "hydroxyl ions" as is recited in claim 15.

Art Unit: 2854

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not support imparting insolubility to the coating with "hydroxyl ions" as recited in claim 15.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Ma et al. (US 5,466,653). Ma et al. teach a printing plate having a substrate with a coating which has been imparted with insolubility with hydroxyl ions. See column 6 lines 24 - 26, column 7 lines 15 - 43, and claims 9, 10, and 21 of Ma et al., for example.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ma et al. in view of Bratt (US 4,072,528). Ma et al. in column 6 refer to Bratt for suitable substrates. In column 5 lines 23 - 44 Bratt disclose the conventionality of an aluminum substrate. It would

Art Unit: 2854

have been obvious to one of ordinary skill in the art to provide the plate of Ma et al. with an aluminum substrate in view of Bratt so as to provide an economical dimensionally stable substrate.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See column 8 lines 1 - 11 and column 9 lines 63 - 67 of Matzinger ('022); column 7 lines 33 - 55 of Furukawa ('908); column 3 lines 52 - 55, column 4 lines 62 - 67, column 7 lines 38 - 42, and column 8 lines 1 - 22 of Leenders et al. ('150); column 9 lines 19 - 49 of Walker et al. ('078); and column 10 lines 29 - 55, column 12 lines 6 - 24, and claim 10 of Titterington et al. ('769).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Tuesday - Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisory, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Application/Control Number: 09/941,304

Page 6

Art Unit: 2854

Stephen Funk  
May 15, 2002

A handwritten signature in black ink that reads "Stephen Funk". The signature is written in a cursive style with a large, looped "S" and "F".

**STEPHEN R. FUNK  
PRIMARY EXAMINER**